

### **Remarks**

Applicants submit this amendment and reply and request entry of the amendments herein. Claims 1-18 are pending; Claims 14-18 are withdrawn from consideration. With this amendment, Claims 2, 11 and 12 have been cancelled. Claims 1, 3, 5, 7, 8, 9 and 13 have been amended, as described below. New Claims 19-24 have been added, as also described below.

Claim 1 has been amended to add proper antecedent basis for the dependent claims; also, in order to expedite prosecution of the current claims, reference to "at least an 8 nucleobase portion" of SEQ ID NO 342 has been deleted. Claims 3, 5, 7, 8 and 9 have been amended to more accurately refer to the claimed invention, and to amend dependencies. Claim 13 has been amended to add proper antecedent basis. Thus, Applicants respectfully assert that no new matter has been added as a result of the amendment to Claims 1, 3, 5, 7, 8, 9 and 13.

New dependent Claims 19-24 have been added to further define compounds within the scope of the invention. Support for new Claim 19 can be found at least at page 17, lines 15-17, and page 28, lines 5-9. Support for new Claims 20 and 22 can be found at least in Example 19 and in Table 14. Support for new Claim 24 can be found on page 52, lines 3-11. Support for the sodium salt of new Claims 21, 23 and 24 can be found at least on page 50, lines 28-30, and page 51, line 11. Thus, no new matter has been introduced in new Claims 19-24.

### **Sequence Compliance**

Applicants have reviewed the specification for all instances of failure to comply with the sequence listing requirement. A new Sequence Listing accompanies this Amendment and Reply. Applicants have also amended the Specification to designate the SEQ ID NO corresponding to each sequence. Applicants respectfully assert that no new matter has been introduced in the new sequence listing or in the amendments to the Specification.

### **Priority Claim**

Applicants thank the Examiner for noting that the claimed subject matter of the instant application does not properly claim priority to the effective filing date of Application Serial No. 10/713, 139 or earlier applications, because SEQ ID NO 342 is first disclosed with the filing of the instant application, i.e., February 6, 2004.

With this Amendment and Reply, Applicants have amended the specification to delete the priority claim found in Paragraph [0001] of the published application (page 1, lines 4-11 of the original specification).

### **Claim Rejection – 35 USC 102**

The Examiner has rejected Claims 1-12 under § 102(b) as being anticipated by Karras (US 6,159,694) and by Monia et al. (US 6,248,586). In order to expedite prosecution, Applicants have amended Claim 1 to delete reference to a compound comprising at least an 8 nucleobase portion of SEQ ID NO: 342. Applicants respectfully assert that the rejection of Claim 1 and dependent Claims 2-12 is now moot.

### **Double Patenting**

The Examiner has rejected Claims 1-12 under the judicially created doctrine of double patenting over US Patent No. 6,159,694. Applicants respectfully assert that the amendment to Claim 1 renders moot the double patenting rejection of Claim 1 and dependent Claims 2-12.

The '694 patent provides a general teaching that antisense compounds may be targeted to the coding region of human STAT3. However, the patent also states that oligonucleotides may be hybridizable with the transcription initiation site region, the translation initiation codon region, the 5' cap region, an intron/exon junction, the coding region, the translation termination codon, or the 5' or 3' untranslated region (see '694 patent, column 4, lines 9-14). The patent also states that preferred regions include the translation initiation codon region (column 4, line 44), the stop codon region (column 4, lines 49-50), the 5' untranslated region (column 4, lines 54-55) and the 3' untranslated region (column 4, lines 59-60). Thus, the '694 patent does not teach the specific sequence comprising SEQ ID NO: 342 or modifications of this specific sequence.

Applicants respectfully request reconsideration of the rejection of Claim 1 and currently pending dependent Claims 3-10 in light of the amendments and arguments presented herein.

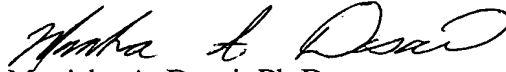
### **Allowable Subject Matter**

Applicants note the Examiner has indicated that Claim 13 is allowable.

Applicants respectfully submit that the amendments to Claim 1 place this claim, as well as Claims 3-10 and 13, in condition for allowance. Applicants earnestly solicit allowance of these Claims as well as new Claims 19-24.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone her at the number provided.

Respectfully submitted,



Manisha A. Desai, Ph.D.

Attorney for Applicants

Registration No. 43,585

Telephone: (317) 433-5333

Eli Lilly and Company  
Patent Division  
P.O. Box 6288  
Indianapolis, Indiana 46206-6288

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